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Amnt Dated March 8, 2004
Reply to Office action of December 12, 2003

REMARKS/ARGUMENTS

Amendments to the Claims

The Applicant has amended claim 1 to specify that the blocking pieces and the scoring pieces each have a distinguishing feature identifying them as blocking pieces and scoring pieces, respectively. It is respectfully submitted that the amended claim is supported by the disclosure, for example by paragraphs 23 and 24, referring to a blocking piece having a first shape and having a "goaltender" imprinted thereon, and to a scoring piece having second shape and having a "hockey player" imprinted thereon, and to Figures 1b and 1c showing both the shape and the images. In each figure, the blocking pieces are shown to have a shape and surface image that is distinct from the shape and surface image of the scoring pieces.

The Applicant has amended claim 15 to correct an inadvertent typographical error.

Similarly, the Applicant has amended claim 20 to specify that the blocking pieces, receiving pieces and scoring pieces each have a distinguishing feature identifying them as blocking pieces, receiving pieces and scoring pieces, respectively. The Applicant has also amended claim 20 to specify that the specific scoring area is defined by at least one portion of the surface of the one or more receiving pieces remaining uncovered by the one or more blocking pieces.

The Applicant has added new claim 40, which includes the limitation that each of the game board, the blocking pieces and the scoring pieces include an image representative of a sport selected from the group consisting of hockey, basketball, soccer and football.

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Claim Rejections – 35 U.S.C. §112

The Examiner had objected to claim 20 as being indefinite. The Applicant has amended claim 20 to specify that the specific scoring area is defined by at least one portion of the surface of the one or more receiving pieces remaining uncovered by the one or more blocking pieces. The Applicant submits that claim 20 now clearly specifies that a specific scoring area is defined by the uncovered surface portions of the receiving pieces, such that the object of the game is to position a scoring piece on one such uncovered surface of the receiving piece(s).

Claim Rejections – 35 U.S.C. §102

The Examiner has rejected claims 1, 5-10 and 16-19 as being anticipated by O'Grady (U.S. Patent 4,305,587). The Applicant respectfully submits that claim 1, as amended, is not anticipated by O'Grady.

The Applicant submits that O'Grady does not disclose blocking pieces. O'Grady provides (at column 3, lines 17 to 19) that where one disc overlaps another, the score earned by the first disc could be cancelled. This is not "blocking". If the first disc served as a "blocking" piece, the overlapping disc would simply receive no score. In contrast, here the overlapping disc is able to cancel the score awarded the first disc, and the Applicant submits that this is mathematically identical to the overlapping disc itself having scored. If the score was 100 (player of overlapped disc) to 50 (player of overlapping disc), and the overlapped disc had scored 40 points, the new score would be 60 to 50, or 10 points apart. If the overlapping disc had scored directly, the score would be 100 to 90, also 10 points apart. In other words, the overlapped disk is not a blocking piece, but an additional way to score.

The Applicant respectfully submits that even if the overlapping discs in O'Grady can be construed as "blocking pieces, such pieces do not have a distinguishing feature to identify them as "blocking pieces", rather than as scoring pieces. In fact, it is clear from the description in O'Grady that any of a player's pieces can be scoring

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pieces. The pieces have no features that could identify them as blocking pieces, and the nature of the function served by the pieces will depend on the progression of game play, and is therefore a function of the rules of the game. In contrast, the applicant claims a game comprising two distinct types of pieces, in addition to the game board: one or more blocking pieces having a distinguishing feature identifying them as such, and one or more scoring pieces having a distinguishing feature identifying them as such (in claim 20, receiving pieces, similarly identified, are also recited) O'Grady, however, only discloses one type of piece, with only one use (for scoring). While the pieces of O'Grady may be given a point value, and may have a particular color to associate them with a team, this does not change the fact that O'Grady provides only a single type of piece for a single purpose.

The Applicant respectfully submits that the Examiner's contention that "blocking pieces" and "scoring pieces" are merely names given to the pieces (and presumably therefore add no functional limitation) is incorrect, and contrary to established case law. In fact, these terms do add a functional limitation to the claims. The Examiner's attention is respectfully directed to the decision of the United States Court of Appeals for the Federal Circuit in *Personalized Media Communications, L.L.C. v. International Trade Commission* (1998), 161 F.3d 696, where the Court, addressing the meaning of the term "digital detector" stated (at pages 704-705):

"Detector" is not a generic structural term such as "means," "element," or "device"; nor is it a coined term lacking a clear meaning, such as "widget" or "ram-a-fram." Instead, as noted by the ALJ by reference to dictionary definitions, "detector" had a well-known meaning to those of skill in the electrical arts connotative of structure, including a rectifier or demodulator. No other extrinsic evidence, including the expert testimony, and no evidence intrinsic to the patent casts doubt on this conclusion. Moreover, neither the fact that a "detector" is defined in terms of its function, nor the fact that the term "detector" does not connote a precise physical structure in the minds of those of skill in the art detracts from the definiteness of structure. [Citation omitted] Even though the

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term "detector" does not specifically evoke a particular structure, it does convey to one knowledgeable in the art a variety of structures known as "detectors." We therefore conclude that the term "detector" is a sufficiently definite structural term to preclude the application of § 112, P 6.

Similarly, in the case of the instant application, it is submitted that the word "piece" will have well known meaning to those of skill in the board game arts, and the fact that it does not connote a precise physical structure does not detract from its definiteness, because it does convey to one knowledgeable in the art a variety of structures known as "pieces". The court went on:

Much of the ALJ's analysis (and the Commission's arguments to this court) centered around the ambiguity raised by the phrase "digital detector." However, *an adjectival qualification ("digital") placed upon otherwise sufficiently definite structure ("detector") does not make the sufficiency of that structure any less sufficient for purposes of § 112, P 6. Instead, it further narrows the scope of those structures covered by the claim and makes the term more definite.* The use of the word "digital" in conjunction with the word "detector" merely places an additional functional constraint (extraction of digital information) on a structure (detector) otherwise adequately defined.

[Emphasis added.]

Thus, the addition of the qualifications "blocking" and "scoring" (and "receiving") to the otherwise sufficiently definite structure "pieces" further narrows the scope of those structures covered by the claim and makes the terms more definite. The qualifications "blocking" and "scoring" are clearly described in the description at, for example, paragraphs 18 and 28, to identify two types of pieces that are different in function and purpose. A blocking piece is not a scoring piece and a scoring piece is not a blocking piece. Accordingly, the Applicant respectfully submits that the Examiner's assertion that "blocking pieces" and "scoring pieces" are merely names given to the pieces is refuted.

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Similarly, the Applicant respectfully submits that the Examiner's position that the playing pieces in the cited reference demonstrate the capability to be used in the same manner as the playing pieces in the claims does not reflect the correct test for the issue of anticipation. The United States Supreme Court held long ago that a prior device capable of being adjusted to operate in the same manner as the patented device does not constitute an anticipation. The Examiner is respectfully referred to the decision of the United States Supreme Court in *Clough v. Barker* (1882), 106 U.S. 166, a case relating to gas burners, where the Court stated (at page 175 to 176):

The testimony as to any additional or supplementary supply of gas in the Horace K. Barker burner amounts really to this only, -- that it [sic] that burner is used now in a way in which it was never designed to be used, and is not shown to have ever been used before Clough's invention, it may be made to [operate in the same way]. ... The structure was not designed for the same purpose as Clough's, no person looking at it or using it would understand that it was to be used in the way Clough's is used, and it is not shown to have been really used and operated in that way.

The court went on to uphold the validity of the patent in that case.

The situation asserted by the Examiner, namely the allegation that the O'Grady playing pieces "demonstrate the capability to be used in the same manner as the playing pieces in the claims", is virtually identical to that dealt with by the U.S. Supreme Court in the above case. Accordingly, the applicant submits that the fact that the O'Grady apparatus might hypothetically have been susceptible to use in a manner similar to the Applicant's invention does not establish anticipation. Again, there is nothing in O'Grady that even remotely suggests such a use of his playing pieces.

Furthermore, the claims, as amended, now specify that the blocking pieces and scoring pieces (and receiving pieces, in the case of claim 20) have

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distinguishing features identifying the function and purpose of each single purpose piece. Thus, it makes no difference whether the O'Grady apparatus might be used to play the Applicant's game, because the apparatus of the present invention is new and inventive there over. By way of example, it is utterly irrelevant that someone might be able to play chess using the pieces of a checkers set (which may include extra checkers) by remembering the role assigned to each checker, as the chess set will still be novel (relative to the checker set) because the chess pieces have distinct physical features denoting their role within the game.

Contrary to the Examiner's assertion, the distinction between blocking pieces and scoring pieces (and, in the case of claim 20, receiving pieces) cannot be said to be merely a function of a method of playing the game. The Applicant has now recited that the nature of each piece is identified by a distinguishing feature, and there is therefore a physical structural distinction between the pieces. Similarly, the Applicant respectfully disagrees with the Examiner's assertion that the recitation "said specific scoring area comprises at least one portion of said general scoring area remaining uncovered by said one or more blocking piece" is merely a method and adds no limitation. The interaction of components with each other can indeed limit the ambit of a claim, in particular with respect to a game apparatus. With respect to the assertion that functional language relating to the method of game play cannot limit an apparatus claim, the Examiner is again respectfully referred to the decision of the United States District Court for the Southern District of New York in *Marvin Glass & Associates v. De Luxe Topper Corporation* (1967), 284 F. Supp. 558 (hereinafter "Marvin Glass"), where the Court specifically stated (at page 562):

Plaintiffs contend, however, that "Silly Safari" infringes the patent under the doctrine of equivalents. [Citation omitted] This contention is without merit since *the object of "Silly Safari" and the way the game is played are substantially different from the object of the game described in the patent and the way that game is played.*

[Emphasis added.]

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The sole independent claim in question was an apparatus claim that read as follows:

A game comprising a game board including a track defining a plurality of stations and having a starting point, a plurality of game pieces for movement along said track from station to station in accordance with numbers selected by lot, a cage, a support for said cage adapted to maintain said cage and [sic] an elevated position above a particular one of said stations, and means adapted to be tripped and to initiate and perform a series of actions terminating in the dropping of said cage to cause said cage to enclose any game piece which may be on said particular station.

It is a well-known maxim of patent law that claim construction must be consistent for both validity and infringement, and the decision in *Marvin Glass* is therefore applicable to the instant anticipation analysis.

Accordingly, as O'Grady does not disclose a game having separate blocking and scoring pieces, and certainly does not disclose separate pieces having distinguishing features identifying their purpose and function, the Applicant respectfully submits that Claim 1 is not anticipated by O'Grady.

The Applicant further submits that claim 20, as amended, is not anticipated by Christian. The Examiner has asserted that Christian teaches a game board for receiving pieces, and blocking and scoring pieces. The Applicant respectfully disagrees.

As amended, claim 20 recites that each receiving, blocking and scoring piece has a distinguishing feature identifying its purpose and function. Thus, claim 20 provides for three distinct types of pieces, each clearly identified: receiving pieces, scoring pieces and blocking pieces. As was explained above with respect to claim 1,

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the distinction between blocking pieces, scoring pieces and receiving pieces cannot be said to be merely a function of a method of playing the game. The Applicant has now recited that the nature of each piece is identified by a distinguishing feature, and there is therefore a physical structural distinction between the pieces.

In contrast, Christian provides for (at most) two types of pieces: a container (14) and a plurality of discs (22). No distinct blocking pieces are disclosed. Christian even alludes (column 3, lines 46 to 49) to the use of indicia to permit players to keep track of their discs, without providing for distinctly marked pieces for different purposes.

Christian does not disclose separate blocking pieces and scoring pieces, each having a distinguishing feature identifying its function and purpose. Christian merely discloses a plurality of single-purpose discs 22, all of which are scoring pieces. Contrary to the Examiner's suggestion that the discs 22 of Christian may be blocking pieces, Christian states specifically that points may be awarded "for knocking other player's markers away". If contact with a marker causes points to be awarded, that marker is not a "blocking piece", it is an additional target.

Furthermore, Christian does not provide for specific scoring areas to be defined by portions of the surface of the receiving pieces remaining uncovered by the blocking pieces, since no blocking pieces are disclosed. Even if the container 14 in Christian were to be construed as a receiving piece, which is disputed, and even if the discs 22 were to be construed as blocking pieces, which is also disputed, Christian specifically recites that "points would be awarded for coming close to the container without actually contacting the container" or for forming strings of discs starting with one that "rounded" the container. Thus, any specific scoring area is not on the surface of the container 14, but rather on the surface of the game board surrounding it, or on one of the surrounding discs 22. Christian does not provide for a specific scoring area defined by portions of the surface of the receiving pieces remaining uncovered by the blocking pieces, and therefore lacks the functional interaction between components recited in claim 20.

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For the reasons outlined above, the Applicant respectfully submits that claim 20, as amended, is patentable over Christian.

Claim Rejections – 35 U.S.C. §103

The Examiner has objected that claims 11-15 are unpatentable over O'Grady in view of Stuart (U.S. Patent Number 4,055,343), cited for the addition of hook and loop attachment means. As noted above, the Applicant submits that claim 1 as amended is patentable over O'Grady. Since claims 11-16 depend either directly or indirectly from claim 1, it is respectfully submitted that these claims are patentable over O'Grady in view of Stewart.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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Attachments
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